



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

ya

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,625	03/08/2004	Bing-Nan Zhou	10209.575	2820

7590 09/23/2005

KIRTON & McCONKIE
Suite 1800
60 East South Temple
Salt Lake City, UT 84111

EXAMINER

LEITH, PATRICIA A

ART UNIT	PAPER NUMBER
----------	--------------

1655

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,625

Applicant(s)

ZHOU ET AL

Examiner

Patricia Leith

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 6-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-24 are pending in the application.

Applicant's election without traverse of Group I, claims 1-5 in the reply filed on 7/7/05 is acknowledged. Claims 6-24 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/7/05.

Claims 1-5 were examined on their merits.

Claim Objections

Claim 1 is objected to because of the following informalities:

Claim 1 recites 'crushed dry'. A comma should properly be placed between 'crushed' and 'dry'. This is considered a minor typographical/gramatical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states 'removing all liquids from said crushed dry leaves to obtain a leaf extract'. This statement is ambiguous in that it appears that Applicant is claiming that the dry leaves *is* the extract. Accordingly, claim 3 states 'wherein the step of removing comprises reducing said crushed dry leaves with heat'. Again, it appears that Applicant intends for the leaves to be an extract which is incorrect in the context of the meaning of the word 'extract'. The Specification teaches that what is actually combined with the fruit juice of *Morinda citrifolia* is an ethanolic extract of *Morinda citrifolia* leaves, whereby the ethanol has been removed from the extract. Although Claim 2 states 'comprising percolating said crushed dry leaves through alcohol and eliminating the alcohol and any alcohol-soluble ingredients from the percolated leaves' is still incomplete because it does not specifically state what the 'leaf extract' is.

A suggestion to overcome these rejections is to reword the claims to read:

1. A method for producing *Morinda citrifolia* leaf serum comprising:
obtaining crushed, dry *Morinda citrifolia* leaves;
extracting said leaves with an alcohol;
collecting the alcohol extract of the leaves;
removing alcohol from the extract to obtain a leaf extract; and
combining said leaf extract with *Morinda citrifolia* fruit juice to obtain a leaf serum.

Claim 3 recites 'reducing said crushed dry leaves with heat'. This is not understood. According to the Specification, it is the ethanolic extract which is reduced with heat, not the already dry leaves (p. 4, Instant specification) Clarification is necessary.

Claim 4 recites 'further comprising processing the fruit of the *Morinda citrifolia* L. plant to obtain *Morinda citrifolia* juice'. First, 'the fruit' lacks antecedent basis in the claim because claim 1 states 'fruit juice'. A suggestion to overcome this rejection is to reword the claim to read:

The method of claim 1 wherein said *Morinda citrifolia* juice is obtained by a step comprising processing the fruit of the *Morinda citrifolia* L. plant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinicke (US 4,666,606).

Heinicke (US 4,666,606) taught a composition high in xeronine and/or proxeronase/proxeroninase content comprising *Morinda citrifolia* juice (aka noni juice)

Art Unit: 1655

which was processed from thawed green noni fruits – col.6, lines 48-64. Heinicke specifically stated that 'Special efforts can be made to increase the xeronine content of the percolate fraction by adding a source of proxeroninase. It has been found that Noni leaf extract or whey may be added to the juice' (col.5, lines 55-58). Heinicke further specifically suggested an extract of whey to be added to the composition (col.5, lines 55-58). The term 'carrier' is given it's broadest interpretation within reason lacking any specific definition of the term 'carrier' within the Instant specification. Therefore, whey extract is considered a 'carrier'.

Heinicke did not specifically teach wherein the noni leaves were crushed and dry, or wherein all of the liquid had been removed.

One of ordinary skill in the art would have been motivated to obtain an extract from dry, crushed noni leaves, as dry noni leaves are essentially devoid of water and therefore easily stored to retain active ingredients therein. One of ordinary skill in the art would have been motivated to extract leaves which have been crushed because plant matter which has been crushed, or essentially comminuted, provides a larger surface area for extraction thereby increasing yield of . One of ordinary skill in the art would have been motivated to remove all liquid after extraction of the leaf in order to remove unwanted liquid and to concentrate the active components of the noni leaf.

No Claims are allowed.

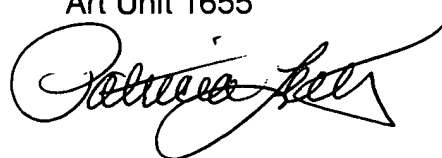
Claim 2 is free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Thursday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campbell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia Leith
Primary Examiner
Art Unit 1655



9/15/05